

Amendment Under 37 C.F.R. § 1.116
U.S. Application No.: 09/971,711

REMARKS

Upon entry of this amendment, claims 2-13 are all the claims pending in the application. Claim 1 has been canceled. No new matter has been added.

Applicant thanks the Examiner for initialing the references listed on form PTO-1449 submitted with the Information Disclosure Statement filed on March 19, 2003.

I. Foreign Priority

In the Amendment filed March 19, 2003, Applicant pointed out that a foreign priority document was filed with the present application on October 9, 2001. Applicant respectfully requested that the Examiner acknowledge the claim for foreign priority and confirm that the certified copy of the priority document was received.

The Examiner, however, has still not acknowledged Applicant's claim for foreign priority or confirmed that the certified copy of the priority document was received. Applicant is enclosing herewith a copy of the PTO transmittal letter which indicates that the priority document was filed with the application. Applicant is also enclosing a copy of the Request for Early Notification of Serial Number, having a PTO stamp date of October 9, 2001 which also indicates that a priority document was filed. In addition, Applicant is enclosing a copy of the front page of the certified copy of the priority document.

In view of the foregoing, Applicant kindly requests that the Examiner acknowledge Applicant's claim for foreign priority and confirm that the certified copy of the priority document has been received.

II. Allowable Subject Matter

Applicant thanks the Examiner for indicating that claims 4, 6 and 8 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant hereby rewrites claims 4 and 8 in independent form, thereby placing the claims in condition for allowance. Claim 6 depends from claim 4 and therefore is patentable at least by virtue of its dependency.

III. Claim Rejections under 35 U.S.C. § 103(a)

A. Claims 1-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuroiwa et al. (U.S. Patent No. 5,296,819) in view of Scheinbeim (U.S. Patent No. 5,369,995) and Bennewitz et al. (U.S. Patent No. 4,379,406). Applicant respectfully traverses this rejection on the following basis.

As a preliminary matter, Applicant notes that the Office Action indicates that claims 1-7 are rejected as shown above. However, the Office Action also indicates that claims 4 and 6 are objected to as being dependent upon a rejected base claim (see Office Action at page 6). As discussed between Applicant's representative and the Examiner on June 19, 2003, the Examiner clarified that claims 4 and 6 are not rejected under 35 U.S.C. § 103(a) but, rather, are objected to as being dependent upon a rejected base claim.

Claim 1 has been canceled by this amendment. Claims 2, 3, 5 and 7 have been amended so as to depend from claim 4. As discussed above, claim 4 has been rewritten in independent

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form, thereby placing the claim in condition for allowance. Accordingly, Applicant submits that claims 2, 3, 5 and 7 are patentable at least by virtue of their dependency.

B. Claims 5 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuroiwa et al. in view of Scheinbeim and Bennewitz et al. and further in view of Sakai et al. (U.S. Patent No. 6,126,312).

Claims 5 and 7 have been amended so as to depend from claim 4. As discussed above, claim 4 has been rewritten in independent form, thereby placing the claim in condition for allowance. Accordingly, Applicant submits that claims 5 and 7 are patentable at least by virtue of their dependency.

C. Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuroiwa et al. in view of Scheinbeim and Bennewitz et al. and further in view of Kojima et al. (U.S. Patent No. 4,713,166). Applicant respectfully traverses this rejection on the following basis.

Claims 9 and 10 have been rewritten in independent form including all of the limitations of base claim 1.

Claim 9 recites the feature of an upper electrode with pores having a size from 0.5-20 μm . Claim 10 recites the feature of a lower electrode with pores having a size from 0.5-20 μm . The Examiner recognizes that the combination of Kuroiwa, Scheinbeim and Bennewitz fails to teach or suggest such features.

In an attempt to cure this deficiency, the Examiner applies Kojima and asserts that Kojima discloses an upper electrode and lower electrode with pores having a size from 0.5-20 μm . Applicant respectfully disagrees.

Contrary to the assertion of the Examiner, Kojima does not disclose an upper electrode or lower electrode with pores having a size from 0.5-20 μm . Rather, Kojima discloses a coating layer 2 which is an Al_2O_3 base ceramic layer having pores with a diameter between 20 and 500 μm (see col. 4, lines 7-10). The Al_2O_3 base ceramic layer, however, clearly does not correspond to an upper electrode or lower electrode as claimed.

That is, while Kojima may arguably disclose a ceramic coating layer 2 having pores from 0.5-20 μm , Kojima clearly does not disclose an upper electrode or lower electrode having pores from 0.5-20 μm , as is required by claims 9 and 10. Indeed, Kojima does not even remotely suggest such a feature.

Accordingly, as the combination of the cited prior art fails to teach or suggest all of the features of claims 9 and 10, Applicant respectfully submits that a prima facie case of obviousness has not been established and kindly requests that the Examiner reconsider and withdraw the rejection.

If the Examiner persists in this rejection, Applicant respectfully requests that the Examiner particularly point out the passages in the cited art which teach the above discussed features so that Applicant may make an informed decision with regard to an appeal.

D. Claims 11-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuroiwa et al. in view of Scheinbeim and Bennewitz et al. and further in view of Tanino et al. (U.S. Patent No. 4,656,455). Applicant respectfully traverses this rejection on the following basis.

Claim 11 has been amended so as to depend from independent claim 4. As discussed above, claim 4 has been rewritten in independent form, thereby placing the claim in condition for allowance. Accordingly, Applicant submits that claim 11 is patentable at least by virtue of its dependency.

Claims 12 and 13 have been rewritten in independent form including all of the limitations of base claim 1.

Claim 12 recites the feature of particles of ceramic incorporated in an amount of 1-20 wt% into the upper electrode. Claim 13 recites the feature of particles of ceramic incorporated in an amount of 1-20 wt% into the lower electrode. The Examiner recognizes that the combination of Kuroiwa, Scheinbeim and Bennewitz fails to teach or suggest such features.

In an attempt to cure this deficiency, the Examiner applies Tanino and asserts that Tanino discloses ceramic incorporated in an amount of 1-20 wt% into an upper electrode and a lower electrode. Applicant respectfully disagrees.

Contrary to the assertion of the Examiner, Tanino does not disclose ceramic incorporated in an amount of 1-20 wt% into an upper electrode and a lower electrode. Rather, Tanino discloses a humidity sensing part which is formed of a ceramic chosen from ZrO_2 , $ZrO_2 + Y_2O_3$,

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and Y_2O_3 . Tanino further discloses that particular combinations of ceramics may be added to one another in varying percentages. For example, Tanino discloses that the proportion of Y_2O_3 to be added to ZrO_2 should range from 10 to 60% by weight (see col. 4, lines 28-46).

Based on the foregoing disclosure, it is clear that Tanino does not disclose ceramic incorporated in an amount of 1-20 wt% into an upper electrode and a lower electrode, as is suggested by the Examiner. Rather, Tanino merely discloses different percentages of ceramics which may be incorporated into other ceramics. There is absolutely no disclosure or suggestion, however, of a ceramic being incorporated into an upper or lower electrode, as is specifically set forth in claims 12 and 13.

Therefore, as the combination of the cited prior art fails to teach or suggest all of the features of claims 12 and 13, Applicant respectfully submits that a prima facie case of obviousness has not been established and kindly requests that the Examiner reconsider and withdraw the rejection.

If the Examiner persists in this rejection, Applicant respectfully requests that the Examiner particularly point out the passages in cited art which teach the above discussed features so that Applicant may make an informed decision with regard to an appeal.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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